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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,153	02/20/2004	Uwe Dahlmann	2003DE410	7039
25255	7590	09/11/2007		
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			EXAMINER ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			09/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,153

Applicant(s)

DAHLMANN ET AL.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II, (claims 9 and 11), and the species of Example 8 in the reply filed on 1/26/07 and 3/9/07 is acknowledged. The claim that reads on the elected invention and species is claim 9. Thus claims 1-8 and 10-11 are withdrawn. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Formula (1) in independent claim 9 is indefinite in regards to $-Y-R^4$ wherein R^4 is set to be M even though at the end of the claim M is said to be a cation. The examiner fails to see how R^4 can be a cation since this would constitute an ionic bond between Y and R^4 , whereas the moiety $-Y-R^4$ clearly designated a covalent bond. In addition, claim 9 is indefinite because there would seem to be a need for an anion to counterbalance the positive charge on the quaternary nitrogen atom.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 9 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Breuer et al. U.S. Patent Number 6,261,346.

Breuer et al. teach a process useful for protecting metal surfaces against corrosion in is presented involving: (a) forming a corrosion inhibitor having a compound corresponding to formula (I): ##STR1## where R.sup.1, R.sup.2 and R.sup.3 independently of one another represent an alkyl or hydroxyalkyl group containing 1 to 4 carbon atoms, an aryl or alkylaryl group or a group corresponding to formula (II): ##STR2## A.sup.- is an anion, n is the number 2 or 3, p is a number of 1 to 3 and R.sup.5 is an alkyl or alkenyl group containing 7 to 23 carbon atoms and 0, 1, 2 or 3 double bonds, and R.sup.4 is a group corresponding to formula (II) or (III): ##STR3## where R.sup.1, R.sup.2 and R.sup.3 are as defined above and Z is a group --

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(CH.sub.2).sub.m -- or a group corresponding to formula (IV): ##STR4## m is an integer of 1 to 6, X is a group NH or an oxygen atom and D is a dimer fatty acid residue containing on average 36 to 54 carbon atoms; (b) combining the corrosion inhibitor with liquid aqueous, liquid non-aqueous or gaseous media; and (c) contacting the corrosion inhibitor with metal. The corrosion inhibitor used in the is biodegradable and shows low aquatic toxicity, see abstract. Compounds according to Breuer et al's invention are deemed to anticipate applicant's compounds of formula (1) when in Breuer et al's formula (I), the R⁴ group is selected to be formula (III) and where Z is selected to be of formula (IV). Such, a selection of groups would result in esterquat compounds that are of the bis-quat type, as are applicant's esterquats, as set forth in applicant's Examples 4-6.

In the alternative, this rejection is being made by way of obviousness since there may not be a direct teaching (i.e. by way of an example) to a compound of Breuer et al. formula (I) where the R⁴ group is actually selected to be of formula (III) and where Z is actually selected to be of formula (IV). It would have been obvious to one having ordinary skill in the art to use Breuer et al's direct disclosure as set forth in the abstract and column 3, lines 60-63, as very strong motivation to actually make compounds that fall within the scope on applicant's formula (1).

Double Patenting

7. Claim 9 of this application conflict with claims 12 and 15-16 of Application No. 10/783,407. 37 CFR 1.78(b) provides that when two or more applications filed by the

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same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claim 9 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of copending Application No. 10/783,407. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

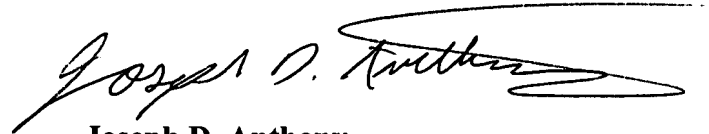
Prior-Art Cited But Not Applied

10. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

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Examiner Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

9/4/07